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09/413,821	10/07/1999	PHILIP KELLER	064965-0141	2466
20277 7590 03/04/2009 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
BOCURE, TESFALDET				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/413,821

**Applicant(s)**

KELLER, PHILIP

**Examiner**

Tesfaldet Bocure

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-16 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on 12/1/08 and claims 1-16 are pending in this Application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al., Cheng hereinafter (US patent number 6,377,666, of a record). Cheng teaches a transceiver unit (fig. 1B) having a transmitter (115) and receiver (117) connected to existing residential wiring (see abstract), where the

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transmitting section comprising: a line driver (207) for transmitting signal over the existing twisted wires being controlled by a controller (113 in fig. 1B and 201 in figure 2); said controller controlling the power level of the line driver through elements 203 and 205 according to the power level for transmitting the signal, high and low power levels (DLC) as in claims 1 and 3.

Further to claims 2 and 4 Cheng also teaches that;

the detection of the power level is determined by the controller once the line circuit is activated (see col. 4, lines 40-50) and reads on the claimed controlling during the initialization of the transceiver in claim 2; the system of Cheng is to accommodate the need of home networking, including computers and printer to share the existing wire line and reads on the claimed specification HPNA in claim 4; and the receiver (117) having a line receiver (209) for receiving signal as in claim 8.

What Cheng fails to teach is that the controller having a comparator for comparing the controlled value levels with a predetermined threshold value in order to generate the driving high and low power level as in claim 1.

However, it is obvious to one of an ordinary skill in the art that the controller of Cheng to have a comparator for generating the high and low power to accommodate two modes of operation (see figs 4A and 4B and col. 8) and control the DC level of the signal to be transmitted through existing telephone line at the time the invention was made.

**Response to Amendment**

5. In response to Applicant's argument that:

Claims 1-8 have been rejected under 35 U.S.C. 103 as being unpatentable over Cheng et al. It is respectfully submitted that this rejection is defective.

Claim 1 recites a method of configuring a transceiver having an output driver for driving an output terminal to provide data transmission via residential twisted pair wiring, the method comprising the steps of: setting a DC level at the output terminal for supplying a transmit signal of a prescribed level to the residential twisted pair wiring, comparing a controlled value representing the DC level with a predetermined threshold level, and controlling the output driver until the controlled value is equal to the threshold level. In accordance with the Guidelines for Determining Obviousness, the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. It is respectfully submitted that the Examiner has failed to articulate any reasons why the subject matter of claim 1 would have been obvious over Chen. Moreover, the Office Action does not even contain a statement that the subject matter of claim 1 would have been obvious over Chen.

Further, the Examiner did not identify any difference between the subject matter of claim 1 and Chen. Therefore, the Examiner has failed to ascertain the differences between the prior art and the claims in issue, as required by the Examination Guidelines for Determining Obviousness and stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 U.S.P.Q. 459, 465 (1966). Accordingly, the rejection of claim 1 is clearly defective.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation and what is lacking in the prior art of

record is clearly stated as indicated in the last office action and as repeated here in this office action.

7. As to Applicant's argument that Examiner did not identify the difference between the claimed subject matter and that of the prior art, the office action states clearly that the art in which the Examiner relied on does not show that the control logic for controlling the power level according to the signal compared to a threshold. However, such generating of a control signal should be compared with a desired value including a threshold value. therefore, the control logic have to have a comparator with a desire value or threshold in order the driver unit to drive the proper signal level to be transmitted depending on the condition of the transmission line.

8. It should also be noted that the claimed language in the instant application and that of the allowable subject matter in claims 5-16 differs from that of the closest art of record, US patent number 6,377,666, in that the "line driver's output is compared for DC level correction" rather than the diving output terminal as claimed in claims 1-4. Therefore, the 'output terminal' has been interoperated as equivalent to the stations 101 and 107 in the prior art of record, which is the output of those terminals and is the once compared rather than the once from the line driver output as claimed and indicated as allowable subject matter in claims 5-16. In other words, the claimed subject matter in claims 1-4 is not calling as the "output of the driver is compared with the threshold," rather from the terminals and as disclosed and shown in figure 3.

***Allowable Subject Matter***

9. Claims 5-16<sup>1</sup> are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tesfaldet Bocure whose telephone number is

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<sup>1</sup> The claim subject matter and as indicated in the allowable subject matter in claims 5-16, the closest reference, US patent number 6,377,666, discloses that the power level, claimed DC level, is compared with the received signal rather than the output of the line driver as claimed. See col. 4, lines 24 in the '666 patent, where the receiver is directed to control the power from the transmitter rather than direct input from the output of the line driver as claimed and shown in

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(571) 272-3015. The examiner can normally be reached on Mon-Thur (7:30a-5:00p) & Mon.-Fri (7:30a-5:00p).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammed H. Ghayour can be reached on (571) 272-3021. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tsfaldet Bocure/  
Primary Examiner, Art Unit 2611

/T. B./  
Primary Examiner, Art Unit 2611